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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/736,525 | 12/17/2003 | Sen-Mei Cheng | BHT-3125-179 | 4345 |
| 7590 | 03/30/2005 | | EXAMINER | |
| TROXELL LAW OFFICE PLLC SUITE 1404 5205 LEESBURG PIKE FALLS CHURCH, VA 22041 | | | BRITTAINE, JAMES R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3677 | |

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------|----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/736,525 | CHENG, SEN-MEI | |
| | Examiner | Art Unit | |
| | James R. Brittain | 3677 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) 1-3 and 6 is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 December 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All . b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: ____.

DETAILED ACTION

Claim Objections

Claims 1-3 and 6 are objected to because of the following informalities: The term “plastics of soft metal” (line 3 of claims 2 and 3) is unclear in context and “plastics or soft metal” is suggested. The term “the decoration member” (claim 1, line 5; claim 3, line 2; claim 6, line 2) lacks clear antecedent basis since a plurality are defined in claim 1, line 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The passage “boost its competitive power in the market” (claim 1, lines 8-9) is a function of unknown scope and it is unclear how this limitation effects the scope of the claim. The boosting of competitive power can occur for many reasons that are not apparent from reading the claim and for this reason the claim is indefinite. The terms “the end thereon” (claim 4, line 5) and “the other end thereof” (claim 6, line 6) lack clear antecedent basis so as to unequivocally indicate which end is being referred to and is therefore indefinite.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the

explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 5 recites the broad recitation "various design", and the claim also recites "such as fruit or balls, etc." which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rose (US 1586473).

Rose (figures 3, 4) teaches a shoelace with variable decoration members comprising a shoelace 3, and two decoration members 5 wherein both ends of the shoelace have an engagement piece 6 attached thereto respectively; the engagement piece thereof has an outermost diameter smaller than the inner diameter of buttonholes of a shoe, and the decoration member 5 is provided with an engaging groove that consists of threads as shown in figure 3 or an annular

groove as shown in figure 4 properly preset at one side thereof to be coupled with the engagement piece thereby, providing a shoelace with variable decoration members attached at both ends thereto to achieve more decoration effect of the shoelace to suit the style of a user. As to claims 2 and 3, the metal used by Rose is sheet metal and is soft compared to other metals such as titanium. In regard to claim 5, the ornaments of Rose can have various designs expressed by the use of different colors.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (US 1586473) in view of Tate (US 2009330).

Rose (figures 3, 4) teaches a shoelace with variable decoration members comprising a shoelace 3, and two decoration members 5 wherein both ends of the shoelace have an engagement piece 6 attached thereto respectively; the engagement piece thereof has an outermost diameter smaller than the inner diameter of buttonholes of a shoe, and the decoration member 5 is provided with an engaging groove that consists of threads as shown in figure 3 or an annular groove as shown in figure 4 properly preset at one side thereof to be coupled with the engagement piece thereby, providing a shoelace with variable decoration members attached at both ends thereto to achieve more decoration effect of the shoelace to suit the style of a user. The threaded species of Rose shown in figure 3 shows a periphery with indented guide facets

forming a threaded formation. There is nothing in the construction of these claims that precludes a threaded formation. The difference is that the engagement piece lacks a conic guide portion and the decoration member lacks a conical engaging section at an end. It would have been obvious to modify the shoelace of Rose such that the engagement piece has a conic guide portion in view of Tate (figure 2) suggesting the use of a frusto-conical guide portion 2 received in a frusto-conical opening end as shown to the left of the seat 10 in figure 2 so as to more easily insert the inner member within the outer member.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents of Weaver et al. (US 5584132, figures 3-5), Kelly (US 1392339, figures 1-4; US 1420632, figures 1-6), Faivre (US 3636594, figure 17), Kimbrough (US 5099552, figure 3), McCrary (US D252236, figures 1-13), Lamy (US 1673080, figure 1), Coffey (US 2961727, figures 1, 5) and Phillips (US 5628589, figure 1) teach pertinent cord end structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is (703) 308-2222. The examiner can normally be reached on M-F 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James R. Brittain
Primary Examiner
Art Unit 3677

JRB